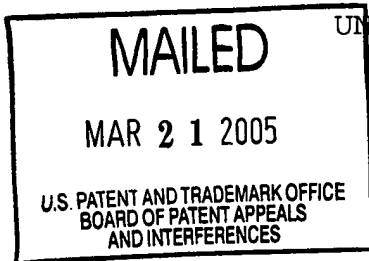


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BIRGIT BOGE,  
JURGEN TRAPPMANN and WOLFGANG HOLSTEIN

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Appeal No. 2004-2132  
Application 09/647,209

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ON BRIEF

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Before COHEN, FRANKFORT and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 2 and 8-35, all of the claims remaining in this application. Claims 3-7 were cancelled by preliminary amendment

upon filing of the national stage application under 35 U.S.C.  
§ 371.

#### THE INVENTION

The invention relates to markings on mineral wool sheets and/or mineral wool plates. The markings serve as cutting or orientation guides and also for product identification.

Representative claims 1, 2 and 26 read as follows:

1. A rollable, mineral wool, insulation material sheet for insulation of roofs, said insulation material sheet having markings distributed over a length of said insulation material sheet which facilitate cutting-off of insulation material sections from said sheet by means of a separating cut, said markings being defined by at least one arrangement selected from the group consisting of:

(a) at least some of said markings being defined on said insulation material sheet with an orientation that is non-perpendicular to a longitudinal axis of said insulation material sheet; and

(b) said markings being defined by plane formations.

2. A rollable, mineral wool, insulation material sheet for insulation of roofs, said insulation material sheet having markings distributed over a length of said insulation material sheet which facilitate cutting-off of insulation material sections from said sheet by means of a separating cut, said markings being formed by crosses, at least some of said crosses being arranged one beside the other with an interval on a perpendicular to the longitudinal axis of said insulation material sheet, and said crosses being arranged with intervals over the longitudinal axis of said insulation material sheet.

26. A rollable, mineral wool, insulation material sheet for insulation of roofs, said insulation material sheet having markings distributed over a length of said insulation material sheet which provide a guide for making oblique cuts with respect to the longitudinal axis of the insulation material sheet, said markings being arranged in a repetitive manner and being defined according to at least one definition selected from the group consisting of:

(a) each said marking being defined by at least one oblique line segment extending in an oblique direction with respect to the longitudinal axis of said insulation material sheet;

(b) each said marking being defined by at least one parallel line segment extending in a direction parallel to the longitudinal axis of the insulation material sheet, said parallel line segments being arranged in rows and defining endpoints wherein at least three endpoints from parallel line segments in adjacent rows are collinear so that they can be connected together to define a line having an oblique angle with respect to the longitudinal axis of the insulation sheet material; and

(c) each said marking being defined by a dot wherein said dots are positioned in uniformly spaced rows and at least three dots from adjacent rows can be connected to define a line having an oblique angle with respect to the longitudinal axis of the insulation material sheet.

#### THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bihiy et al. (Bihiy)	4,866,905	Sep. 19, 1989
Kaufmann et al. (Kaufmann) (German Offenlegungstag)	3713108 A1	Dec. 10, 1987
Naber (European published patent application)	795424 A1	Sep. 17, 1997

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THE REJECTIONS

Claims 1, 2 and 8-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bihiy.

Claims 1, 2 and 8-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann.

Claims 1, 2 and 8-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Naber.<sup>1</sup>

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<sup>1</sup> Although the examiner's rejection set forth on page 4 of the examiner's answer indicates that claims 1, 2 and 8-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 795424 A1 (Naber), we note that the body of the rejection recognizes that Naber "is silent to the specific graphic design claimed instantly" (examiner's answer, page 5) and goes on to urge that "it would have been a matter of obvious design choice to have provided" the mineral wool insulation material of Naber with "any specific such design meeting the disclosed function motivated by the desire to provide a user with convenient instructions or improved aesthetics." Thus, notwithstanding the statement of rejection as being based on 35 U.S.C. § 102(b) anticipation, we view the examiner's rejection as being based on 35 U.S.C. § 103(a) and will treat the rejection accordingly.

OPINION

Having carefully reviewed the obviousness issues raised in the appeal in light of the record before us, we have made the determinations that follow.

Bihiy

The examiner's rejection of claims 1, 8, 10, 12, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Bihiy is sustained. We first note that claim 1 utilizes alternative language to describe the arrangement of the markings used for the cutting off of insulation material sections from the rollable mineral wool sheet. "When a claim covers several structures . . . as alternatives, the claim is deemed anticipated if any of the structures . . . within the scope of the claim is known in the prior art."<sup>2</sup> More specifically, we observe that section (b) of claim 1 requires "said markings being defined by plane formations." We cannot find a definition of "plane formations" in appellants' specification. Therefore, we give the terminology

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<sup>2</sup> Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir., 2001), cert. denied, 535 U.S. 970 (2002).

"plane formations" its "broadest reasonable interpretation."<sup>3</sup> In so doing, we find that "plane formations" means that the markings on the mineral wool insulation sheet material are two-dimensional and arranged in a plane.

With the above interpretation in mind, we note that Bihi shows markings (5) defined by "plane formations" (i.e. markings which are two-dimensional and arranged in a plane). See Figure 1. Since the alternative limitation of section (b) of claim 1 reads on the rollable, mineral wool sheet of Bihi, the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is sustained. In that regard, we note that anticipation or a lack of novelty is the ultimate or epitome of obviousness.<sup>4</sup>

Concerning dependent claims 8, 10, 12, 18, 20, 22 and 24, we note that appellants have indicated on page 3 of their brief that

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<sup>3</sup> In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir., 1997).

<sup>4</sup> In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA, 1982).

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these claims are grouped to stand or fall with claim 1. Thus, given our disposition of claim 1 above, it follows that the examiner's rejection of claims 8, 10, 12, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also sustained.

The examiner's rejection of claims 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is sustained. Claim 14 requires markings "formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles, and parallelograms." The marking lines (5) shown by Bihi in Figure 1 are rectangular in configuration and comprise filled rectangles with a length greater than the width. Claim 14 does not require the geometrical patterns to be of an open configuration as shown, for example, in Figures 2, and 5-7 of appellants' disclosure. Since the further limitation broadly set forth in claim 14 reads on the markings shown in Bihi, the examiner's rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is sustained.

Regarding claim 16, we note that appellants have indicated on page 3 of their brief that claim 16 is grouped to stand or fall with claim 14. Thus, given our disposition of claim 14 above, it follows that the examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also sustained.

The examiner's rejection of claims 2, 9, 11, 13, 15, 17, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is reversed. Claim 2 requires "markings being formed by crosses" arranged at intervals along the longitudinal axis and perpendicular to the longitudinal axis of the sheet. In contrast, Bihi shows a rollable insulation sheet with marking lines (5) provided perpendicular to the longitudinal axis of the sheet. The marking lines facilitate the cutting off of a length of an insulation sheet corresponding to the width of a rafter area to be insulated such that several individually cut sheets can be serially installed transverse to the rafter area rather than a single insulation panel or sheet manufactured with a



defined width installed lengthwise. Bihiy overcomes the disadvantages of providing rollable insulation sheets in different nominal widths, and the waste that is attendant with the prior art suggestion of providing marking lines parallel to the longitudinal axis to facilitate trimming the width of rollable insulation sheets. Note particularly the disclosure of Bihiy at column 2, line 43 to column 3, line 28. Bihiy does not teach or suggest cutting the insulation material in any other direction besides perpendicular to the longitudinal axis. Given the specific nature of the rollable insulation sheet and markings (5) thereon and its method of use set forth in Bihiy, we see no basis for the examiner's proposed modification of Bihiy's rollable insulation sheet and no reason to contemplate markings formed by crosses arranged in the manner set forth in claim 2 on appeal. Therefore, the examiner's rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Bihiy is reversed.

With respect to dependent claims 9, 11, 13, 19, 21, 23 and 25, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 2. Given our

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disposition of independent claim 2 above, it follows that the examiner's rejection of claims 9, 11, 13, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also reversed.

Regarding claims 15 and 17, appellants have indicated on page 3 of their brief that these claims stand or fall together, however, claims 15 and 17 are ultimately dependent on claim 2. Given our disposition of independent claim 2 above, it follows that the examiner's rejection of claims 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also reversed.

The examiner's rejection of claims 26-35 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is reversed. Claim 26 specifically requires that the markings distributed over the length of the insulation material sheet "provide a guide for making oblique cuts." To that end, claim 26 requires in the alternative that each marking is "defined by at least one oblique line segment extending in an oblique direction with respect to the longitudinal axis," or "defined by at least one parallel line

segment extending in a direction parallel to the longitudinal axis [and] arranged in rows and defining endpoints wherein at least three endpoints from parallel line segments in adjacent rows are collinear so that they can be connected together to define a line having an oblique angle with respect to the longitudinal axis of the insulation sheet material," or "defined by a dot wherein said dots are positioned in uniformly spaced rows and at least three dots from adjacent rows can be connected to define a line having an oblique angle with respect to the longitudinal axis of the insulation material sheet." As explained before, Bihi shows markings (5) provided perpendicular to the longitudinal axis of the rollable insulation sheet for the particular purpose of cutting off lengths of the insulation sheet. Bihi does not teach or suggest cutting the insulation material in any other direction besides perpendicular to the longitudinal axis. Again, given the specific nature of the rollable insulation sheet and markings thereon and method of use disclosed in Bihi, we find no basis for the examiner's proposed modification of Bihi's rollable insulation sheet and no reason to even contemplate markings to facilitate providing a guide for

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making oblique cuts. Therefore, the examiner's rejection of independent claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is reversed.

Regarding dependent claims 29 and 32-35, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 26. Thus, given our disposition of claim 26 above, it follows that the examiner's rejection of claims 29 and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also reversed.

Regarding claims 27, 28, 30 and 31, appellants have indicated on page 3 of their brief that these claims stand or fall together, however, claims 27, 28, 30 and 31 are ultimately dependent on claim 26. Given our disposition of independent claim 26 above, it follows that the examiner's rejection of claims 27, 28, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Bihi is also reversed.

Kaufmann

The examiner's rejection of claims 1, 8, 10, 12, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. As discussed above, claim 1 utilizes alternative language to describe the arrangements of markings on the rollable insulation sheet. The discussion of the definition of "plane formations" above is incorporated by reference. Kaufmann shows markings (42, 43) defined by plane formations (i.e. markings which are two-dimensional and arranged in a plane) as required by section (b) of claim 1. See Figure 2. Furthermore, Kaufmann also meets the alternative limitation of section (a) of claim 1 which requires "at least some of said markings being defined on said insulation material sheet with an orientation that is non-perpendicular to a longitudinal axis of said insulation material sheet" because the translation of Kaufmann on page 10, lines 1-2, discloses that grid markings can be generated on the mineral wool sheet by the heating rods of the device. Although not illustrated, it is our view that at least some of the lines forming the grid in Kaufmann would have an orientation that is non-perpendicular to the longitudinal axis of

the insulation material sheet. Since Kaufmann, in one form or another, is responsive to both alternative limitations (a) and (b) of claim 1, the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Again, we note that anticipation or a lack of novelty is the ultimate or epitome of obviousness.<sup>5</sup>

Regarding dependent claims 8, 10, 12, 18, 20, 22 and 24, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 1. Thus, given our disposition of claim 1 above, it follows that the examiner's rejection of claims 8, 10, 12, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is also sustained.

The examiner's rejection of claims 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Claims 14 and 16 require the markings to be "formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles, and parallelograms."

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<sup>5</sup> Id.

As discussed above, Kaufmann discloses that grid markings can be generated by the heating rods of the device. Although not illustrated, the necessary intersecting lines of the grid markings form squares, rectangles or parallelograms. Since Kaufmann describes at least one of the alternative limitations of claims 14 and 16, the examiner's rejection of claims 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

The examiner's rejection of claims 2, 9, 11, 13, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Claim 2 requires the markings to be "formed by crosses, at least some of said crosses being arranged one beside the other with an interval on a perpendicular to the longitudinal axis of said insulation material sheet, and said crosses being arranged with intervals over the longitudinal axis of said insulation material sheet." As discussed above, Kaufmann discloses that grid markings can be generated by the heating rods of the device. Although not illustrated, the requisite intersections of the grid marking lines will form crosses arranged one

beside the other with an interval on a perpendicular to the longitudinal axis of an insulation material sheet and arranged with intervals over the longitudinal axis of the insulation material sheet. We do not see that the broad language of claim 2 requires an arrangement of markings in the form of crosses wherein there is an unmarked space between the crosses both longitudinally and transversely of the insulation material sheet. In Kaufmann, the "intervals" between the crosses are defined by straight line segments that interconnect the crosses both longitudinally and transversely of the insulation material sheet. Since the limitations of claim 2 read on Kaufmann, the examiner's rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

Regarding dependent claims 9, 11, 13, 19, 21, 23 and 25, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 2. Thus, given our disposition of claim 2 above, it follows that the examiner's rejection of claims 9, 11, 13, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is also sustained.



The examiner's rejection of claims 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Claims 15 and 17 require the markings to be "formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles, and parallelograms." As discussed above, Kaufmann discloses that grid markings can be generated by the heating rods of the device. As discussed above with respect to claims 14 and 16, the grid marking lines form squares, rectangles or parallelograms. Since Kaufmann is responsive to at least one of the alternative limitations in claims 15 and 17, the examiner's rejection of claims 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

The examiner's rejection of claims 26, 29 and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Claim 26 also utilizes alternative language to describe the arrangement of markings on the rollable insulation sheet. Section (b) of claim 26 requires "each said marking being defined by at least one parallel line segment extending in a

direction parallel to the longitudinal axis of the insulation material sheet, said parallel line segments being arranged in rows and defining endpoints wherein at least three endpoints from parallel line segments in adjacent rows are collinear so that they can be connected together to define a line having an oblique angle with respect to the longitudinal axis of the insulation sheet material." As discussed above, Kaufmann discloses that grid markings can be generated by the heating rods of the device. The necessary lines forming the grid markings define at least one parallel line segment extending in a direction parallel to the longitudinal axis of the insulation material sheet, the parallel line segments being arranged in rows and defining at each transversely oriented line of the grid markings, endpoints wherein at least three endpoints from parallel line segments in adjacent rows are collinear so that they can be connected together to define a line having an oblique angle with respect to the longitudinal axis of the insulation sheet material. Since the alternative limitation of section (b) of claim 26 is readable on Kaufmann's grid markings, the examiner's rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

Regarding dependent claims 29 and 32-35, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 26. Thus, given our disposition of claim 26 above, it follows that the examiner's rejection of claims 29 and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is also sustained.

The examiner's rejection of claims 27, 28, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained. Claim 27 requires that the "parallel line segments are part of a polygon." As discussed above, Kaufmann discloses an embodiment wherein grid markings are generated by the heating rods of the device. Although not illustrated, the grid markings consist of line segments both parallel to and perpendicular to the longitudinal axis. The parallel and perpendicular line segments forming the grid markings also form polygons in the shape of squares, rectangles or parallelograms. Since Kaufmann is responsive to the limitations of claim 27, the examiner's rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

With respect to claims 28, 30 and 31, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 27. Thus, given our disposition of claim 27 above, it follows that the examiner's rejection of claims 28, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is also sustained.

Naber

Regarding the examiner's rejection of claims 1, 8, 10, 12, 14, 16, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Naber, the discussion of alternative claim language and the meaning of "plane formations" above with respect to the Bihiy reference is incorporated by reference. Naber shows an apparatus for marking insulation sheets with a stamp block (12) having linear heating elements (14). See Figures 1 and 2. As noted on page 11 of the translation, the linear heating elements (14) apply markings across the entire width of the sheet as the sheet moves during the production process. The markings produced on the end product insulation sheet by the process and apparatus of Naber comprise "plane formations" similar to the

Bihi insulation sheet, with the difference being that the marking lines in Naber extend lengthwise across the entire width of the insulation sheet. Since Naber is responsive to the alternative limitation of section (b) of claim 1, the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Naber is sustained. Again, we note that anticipation or a lack of novelty is the ultimate or epitome of obviousness.<sup>6</sup>

Regarding dependent claims 8, 10, 12, 18, 20, 22 and 24, we note that appellants have indicated on page 3 of their brief that these claims are grouped to stand or fall with claim 1. Thus, given our disposition of claim 1 above, it follows that the examiner's rejection of claims 8, 10, 12, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also sustained.

The examiner's rejection of claims 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Naber is sustained. Claim 14

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<sup>6</sup> Id.

requires markings "formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles, and parallelograms." Each of the markings generated on an insulation sheet by the process and apparatus of Naber comprises a rectangular configuration having a minimal width and a length equal to the width of the insulation sheet. As discussed above, claim 14 does not require that the geometrical patterns be of an open configuration as shown in Figures 2 and 5-7 of appellants' disclosure. Since Naber is responsive to the further limitation of claim 14, the examiner's rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Naber is sustained.

Regarding claim 16, we note that appellants have indicated on page 3 of their brief that claim 16 is grouped to stand or fall with claim 14. Thus, given our disposition of claim 14 above, it follows that the examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also sustained.

The examiner's rejection of claims 2, 9, 11, 13, 15, 17, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Naber is reversed. Claim 2 requires "markings being formed by crosses" arranged at intervals along the longitudinal axis and perpendicular to the longitudinal axis of the sheet. The examiner has not provided an evidentiary basis for the proposed modification of the end product insulation sheet produced by the process and apparatus of Naber necessary to arrive at the insulation sheet claimed by appellant. More specifically, absent hindsight, we see no basis for modifying the insulation material of Naber so as to have markings formed by crosses arranged in the particular manner set forth in claim 2 on appeal. Therefore, the examiner's rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Naber is reversed.

With respect to dependent claims 9, 11, 13, 19, 21, 23 and 25, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 2. Thus, given our disposition of claim 2 above, it follows that the examiner's

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rejection of claims 9, 11, 13, 19, 21, 23 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also reversed.

Regarding claims 15 and 17, appellants have indicated on page 3 of their brief that these claims stand or fall together, however, claims 15 and 17 are ultimately dependent on claim 2. Given our disposition of claim 2 above, it follows that the examiner's rejection of claims 15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also reversed.

The examiner's rejection of claims 26-35 under 35 U.S.C. § 103(a) as being unpatentable over Naber is reversed. As explained before, claim 26 specifically requires that the markings distributed over the length of the insulation material sheet "provide a guide for making oblique cuts." Claim 26 requires in the alternative that each marking is "defined by at least one oblique line segment extending in an oblique direction with respect to the longitudinal axis," or "defined by at least one parallel line segment extending in a direction parallel to the longitudinal axis [and] arranged in rows and defining



endpoints wherein at least three endpoints from parallel line segments in adjacent rows are collinear so that they can be connected together to define a line having an oblique angle with respect to the longitudinal axis of the insulation sheet material" or "defined by a dot wherein said dots are positioned in uniformly spaced rows and at least three dots from adjacent rows can be connected to define a line having an oblique angle with respect to the longitudinal axis of the insulation material sheet." Again, the examiner has not provided an evidentiary basis for the proposed modification of the end product insulation sheet produced by the process and apparatus of Naber necessary to arrive at the insulation sheet claimed by appellants. Absent hindsight, we see no basis for modifying the insulation material of Naber to facilitate cutting of the insulation material using markings of the type set forth in claim 26 on appeal for making oblique cuts. Therefore, the examiner's rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Naber is reversed.

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Regarding dependent claims 29 and 32-35, we note that appellants have indicated on page 3 of their brief that these claims stand or fall with claim 26. Thus, given our disposition of claim 26 above, it follows that the examiner's rejection of claims 29 and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also reversed.

With respect to claims 27, 28, 30 and 31, appellants have indicated on page 3 of their brief that these claims stand or fall together, however, claims 27, 28, 30 and 31 are ultimately dependent on claim 26. Given our disposition of independent claim 26 above, it follows that the examiner's rejection of claims 27, 28, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Naber is also reversed.

#### SUMMARY

In summary:

The examiner's rejection of claims 1, 8, 10, 12, 14, 16, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Bihiy is sustained.

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The examiner's rejection of claims 2, 9, 11, 13, 15, 17, 19, 21, 23 and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over Bihiy is reversed.

The examiner's rejection of claims 1, 2 and 8-35 under 35 U.S.C. § 103(a) as being unpatentable over Kaufmann is sustained.

The examiner's rejection of claims 1, 8, 10, 12, 14, 16, 18, 20, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Naber is sustained.

The examiner's rejection of claims 2, 9, 11, 13, 15, 17, 19, 21, 23 and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over Naber is reversed.

#### NEW GROUNDS OF REJECTION

Given that at least one rejection of each of the claims on appeal has been sustained, the decision of the examiner rejecting claims 1, 2 and 8 through 35 on appeal is affirmed.

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However, since our rationale for sustaining the various rejections indicated above is somewhat different than that set forth by the examiner, we denominate each as a new ground of rejection under 37 CFR § 41.50(b).

The decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004). 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) Request rehearing. Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record. . . .

#### FURTHER PROSECUTION

In the event of further prosecution, attention is directed to claims 15, 17, 19 and 21. Claims 15 and 17 require the markings formed by crosses as set forth in claim 2 (and shown in Figure 8) to also be formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles and parallelograms. It is unclear how markings formed by crosses can also be formed by geometrical patterns selected from the group consisting of trapezoids, squares, rectangles, triangles and parallelograms. We cannot find in the specification a description of such an embodiment. Claims 19 and 21 require the markings formed by crosses as set forth in claim 2 (and shown in Figure 8) to also be formed by dot-shaped formations. It is unclear how markings formed by crosses can also be formed by dot-shaped formations. Again, we can find no description in the specification describing such an embodiment. The examiner should consider a possible rejection of claims 15, 17, 19 and 21 under 35 U.S.C. § 112, first and second paragraphs.


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Attention is directed to Vettters et al. (EP 0795659 A1), cited by applicant in the Information Disclosure Statement filed 9/27/00. Vettters et al. shows in Figure 4 a mineral wool sheet with a grid or crossed markings. Attention is also directed to Royar et al. (Royar) (DE 3229601 A1) and Pankätz (DE 3203624 A1, English language equivalent U.S. Pat. No. 4,879,157) that were described as prior art in the Bihy reference. Royar shows markings defined by "plane formations" and defined on the insulation material sheet with an orientation that is non-perpendicular and also parallel to the longitudinal axis of the insulation material sheet in order for width of the insulation sheet to be trimmed. Pankatz shows insulation plates that have been cut into right triangles. The hypotenuse of the right triangles is defined by an oblique cut. The insulation plates cut into right triangles provide the ability to install insulation at various widths to fit between different rafter spacings. Pankatz appears to provide a motivation for oblique cutting guides for insulation since it is desirable to have insulation plates with at least one oblique surface to provide insulation at various widths. The examiner should consider

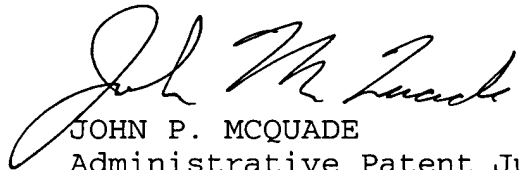
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appropriate rejections under 35 U.S.C. §§ 102, or 103 as  
applicable.

AFFIRMED, 37 CFR § 41.50(b)

  
IRWIN CHARLES COHEN  
Administrative Patent Judge

  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
JOHN P. MCQUADE  
Administrative Patent Judge

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Application 09/647,209

VAN DYKE, GARDNER, LINN AND BURKHART, LLP  
2851 Charlevoix Drive, S.E.  
P.O. Box 888695  
Grand Rapids, MI 49588-8695